

REMARKS

Claims 23-40 are pending; claims 1-22 having previously been cancelled. New claims 35-40 have been added to link in a more direct manner the invention of condensing a baseball game as defined by the originally examined claims to a business method in which revenue is received in exchange for the right to view the condensed game. Support for these claims can be found, *inter alia*, in the first full paragraph of page 2 in the original application and in paragraph [007] of the substitute specification. While presented as independent claims, to a certain extent, these new claims can be considered derivative of the previously pending claims which recited obtaining subscribers for viewing the edited recording and should properly be examined with the pending claims.

No new matter has been added by these amendments.

This amendment is accompanied by an Express Abandonment of applicants' child application Serial No. 10/858,470.

The pending claims are directed to a novel method of presenting a baseball game in a condensed fashion for viewing (and re-viewing) and for generating additional revenue. The claims are supported by the original application and do not add any new matter.

Those skilled in the relevant art are well-versed in the conduct of a typical baseball game and with that understanding of a skilled worker, the pending claims are clear and definite. The claims have been amended (claims 23 and 24) and the new claims presented (claims 35 and 38) in a way such that they are directed specifically to a method in which a baseball game (*e.g.*, an analog or digital recording thereof) is edited, such as on an inning-, or half-inning-by inning

basis, or following the completion of the complete game, to remove “substantially” all aspects of the pre-recorded game that do not directly impact the outcome of the game, *i.e.*, save for the outcome-determinative action associated with each batter that comes to the plate and a minor amount of additional content (such as between inning banter by the announcers, occasional crowd shots, or certain foul balls that may have fan interest). In this way, essentially all the action of an entire baseball game that is reflected in the box score for each participant in the game is consolidated or condensed into about 10-20 minutes of video.

The newly added claims find support in the specification (Amended) for the added limitation of obtaining subscribers for viewing the broadcast of the edited recording, for example, in paragraph [0007]. New claims 35 through 40 parallel original claims 23, 24, 27, 29, 32 and 33 but include the added step of offering the edited recording to subscribers in exchange for compensation.

Please recall that a Rule 131 declaration by the inventors was previously filed in this application. In this Declaration, the inventors swore behind a Major League Baseball (MLB) Press Release dated March 27, 2001, which announced an agreement between MLB Advanced Media and RealNetworks (this was done prior to the granting of applicants’ petition for a filing date which ultimately entitled them to benefit of a June 13, 2000 provisional filing date). As documented in the declaration, prior to that time the inventors had disclosed their invention to a representative of MLB.

At the outset, applicants request that the Examiner confirm that the Second Rule 312 Amendment filed on or about June 25, 2004 which amended the Specification to assert benefit under 35 USC 119 of previously filed Provisional Application 60/211,208 has been entered. If not, applicants request that the undersigned representative be notified so that a Supplemental Amendment can be filed for that purpose.

The current Office Action issued following the withdrawal of a prior Notice of Allowance issued over a year ago, *i.e.*, on February 24, 2004.

Claims 23-34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over SeasonTicket in view of Rangan et al, U.S. 6,493,872. This rejection is respectfully traversed.

The comments made in the Office Action, presumably made in support of the rejection, evidence a complete lack of an understanding of the claimed invention. The claimed invention, as defined by each of the independent claims, is a method. That method may require as one of its steps the preparation of an edited recording, but the edited recording itself is not claimed. Thus, the assertion in the Office Action that “the content of an edited video contains no patentable novelty” is irrelevant and inappropriate. Applicants do not understand the purpose for that comment in the Office Action. The claims do not embrace an edited video.

The Office Action also contends, in referring to the primary cited reference, that “SeasonTicket discloses recording personalized sport video highlight shows (page2 2nd paragraph). The duration and subject matter recorded is a matter of design choice to the viewer.”

It appears that the Office Action reads more into this service than actually may have been involved. Applicants request that the Examiner explain in detail the basis for his interpretation

of this reference. If that interpretation is based on facts within his personal knowledge (or the knowledge of someone else in the Office), applicants request the issuance of an affidavit under 37 CFR 1.104(d)(2). Applicants do not believe the “viewer” had any input into the original content of the highlights themselves (as it appears the Office Action assumes).

Applicants’ understanding of the service embraced by the cited reference is that a subscriber first defines an area of interest (it may be a single sport, it may be a set of teams from a single town, it may be several teams of different sports and different towns). Having defined that area of interest, SEASONTICKET then sends only those highlights, of the full set of highlights that it has access to, that fall within the defined area of interest for that subscriber. For example, a subscriber who expresses an interest only in the Boston Red Sox’s (baseball) and the Oakland Raiders (football) would only be sent the highlights, of all the highlights otherwise available through SEASONTICKET, for only those two teams. Highlights of other teams and other sports that might otherwise be available for viewing through SEASONTICKET would not be sent to that particular subscriber. Nothing is said in the reference document about the content of the highlight itself.

Such a service and the method of its implementation neither discloses, nor suggests the method defined by the pending claims.

The Office Action also asserts that “the specification provides no unexpected results in recording the action plays of the game.” This comment illustrates the Office Action’s attempt to shift the burden of demonstrating patentability to applicants. It is the burden of the Patent and Trademark Office (PTO) to present a *prima facie* case of obviousness of the invention defined by

applicants' claims, it is not applicants' burden to show the "criticality" or "unexpected results" of the invention, unless and until the PTO *prima facie* shows that the invention (method) would have been obvious to a person of ordinary skill in the art. As demonstrated below, the rejection does NOT present a *prima facie* case of obviousness.

The Office Action argues that deciding what portion of a pre-recorded video to select (or edit) is simply a design choice ("editing decision"). But, the exercise of a design choice is at the heart of any invention that involves a new way of using established technology. Such an approach to assessing patentability ignores the proper method for determining the issue of non-obviousness established by the U.S. Supreme Court in *Graham v. Deere*. In the present case, the claimed method involves a pre-selection of the content of the edited recording that breathes patentability into the invention – the attempt in the Office Action to denigrate that novel and nonobvious selection of content as simply a matter of design choice is based completely on an improper hindsight evaluation of the claimed invention.

The proper question, when addressing the issue of patentability, is whether it would have been obvious to a skilled worker to use the known technology in the manner embraced by the pending method claims. The fact that the invention is one of an infinite numbers of "choices" that confronts a worker of ordinary skill, when using such established technology to edit a video recording, is of no moment. It is only when illuminated by the improper light of hindsight that the present invention would in any way be considered by a skilled worker.

The invention is NOT directed to simply making a "highlight" tape of a baseball game, as for example one might see on ESPN's SportCenter. Rather, the invention is directed to a

particular pre-selected method of editing a pre-recorded baseball game to show essentially all of and essentially only all of the outcome-determinative pitches to each batter; while substantially eliminating all non-outcome-determinative action from the edited recording. In this way the edited video shows substantially only the outcome of each at bat in the game, such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc. Obviously, such a record is not merely a highlight reel. The concept of making a highlight tape does not suggest making such a pre-selected, edited record of an entire baseball game in the manner defined by the pending claims.

Thus, when one assesses the differences between the cited prior art and the subject matter defined by the pending claims, as required by *Graham v. Deere*, one sees that the actual content of the potential recordings is substantially different. A set of highlights, as practiced by the prior art, captures only a few to possibly a dozen events in the course of a game, and generally represents a subjective assessment of those aspects of the game that a viewer might find particularly interesting. The present invention, in contrast, establishes an objective, pre-selection of the game action to be included, selecting essentially all of the game action that contributes to the box score of the game. There is nothing in the prior art cited by the Examiner that in any way suggests that one could predicate a new business method, *i.e.*, produce a new product, that would be in demand, *i.e.*, have intrinsic value, independent of common highlight videos by capturing the action of a baseball game in this manner, *i.e.*, by distilling the recording of a baseball game down to essentially only those actions that contribute directly to the outcome of the contest, such as the result that occurs following the last pitch thrown to each batter for

each turn at the plate, or the tagging out or safe advancement of a base runner as may occur in a pick-off play or if the runner is caught stealing. Based on applicants' teachings, anyone with even a rudimentary knowledge of the game of baseball can envision what aspects of the pre-recorded game to exclude and what to retain in the editing process to accomplish the stated result – there is nothing subjective in carrying out the claimed method.

However, before the disclosure of applicants' teachings, there is not one shred of evidence that those of ordinary skill would have envisioned conducting such a method and preparing such a product. Of course, one can, within the spirit of this invention, include a minor amount of extraneous recorded information in the edited version according to the present invention, *e.g.*, a video clip of a young fan watching the game, or a video clip of a coach or manager giving signals or changing the pitcher, so as to accent the summary presentation provided by this invention. Thus, the use of such words as “essentially” and “substantially,” which the Federal Circuit has repeatedly acknowledged are terms implying approximation not exactness, to modify certain aspects of the claimed method, prevents one from slavishly limiting the literal scope of the method to the essential actions. The objective of the invention is to present a complete summary of the action that is recorded in the original game, as reflected in the box score for each participant in the game, so that the action is consolidated into about 10-20 minutes of video.

Indeed, if the claimed method was simply an obvious design choice, why then did Major League Baseball call it “revolutionary” when it first introduced its offering of “Condensed Games.” “Major League Baseball (MLB) today announced the debut of a revolutionary new

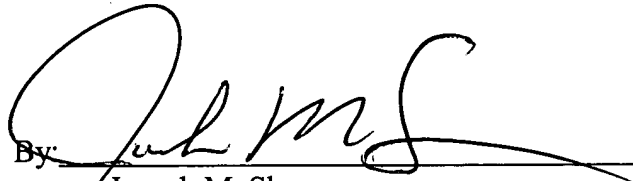
baseball video service.” (Press Release of March 5, 2002 – Additional copy enclosed for convenience but previously submitted with August 27, 2003 Information Disclosure Statement). MLB’s own glowing characterization of this method of doing business stands as a powerful testament of the non-obviousness of the claimed method. This objective indication of the non-obviousness of the method must be considered when evaluating the patentability of the claimed method. The adoption by MLB of this business method, decades after pre-recording of baseball games was begun and years after the technology of providing such a product/service over the internet was available, stands as an uncontested tribute to the ingenuity and inventiveness of the claimed method. We submit that such third party commentary unequivocally demonstrates the patentability of the subject matter defined by the pending claims.

The citation of the secondary reference Rangan, US 6,493,872 is particularly inappropriate and does not address any of the glaring shortcomings of the primary reference. Rangan describes technology for synchronizing audio and video data streams from different points of origin. Nothing regarding a baseball-related product is mentioned.

Claims 23-24 also were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 41-15 of their co-pending application Serial No. 10/858,470 in view of Rangan. Applicants are expressly abandoning that co-pending application. This rejection is no longer appropriate.

On the basis of the foregoing, prompt consideration and an allowance of all claims in the subject application are respectfully requested.

Respectfully submitted,

By: 

Joseph M. Skerpon
Registration No. 29,864

June 10, 2005

BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001-4597
(202) 824-3000

895576-1



Scoreboard Teams/Players News Stats Schedule Standings Tickets Fantasy Auction Shop SimLe
Audio Video Transactions Injuries Minor Leagues History Kids Fan Forum Events Spring Training



3/5/2002 10:30 am ET

MLB Advanced Media adds new "star" to video lineup in 2002

Revolutionary condensed game video joins popular returning starters from last season

MLB Advanced Media press release

- o Watch the Condensed Game demo: three innings of Game 3 of the 2001 World Series

NEW YORK, NY, March 5, 2002 – MLB Advanced Media, LP (MLBAM), the interactive media and Internet company of Major League Baseball (MLB), today announced the debut of a revolutionary new baseball video service to its starting lineup for the 2002 season, *MLB.com Condensed Games*.

MLB.com Condensed Games ("Not Just Baseball, Fastball!") joins a host of exclusive audio and video services that made their debut last season. Fans will be able to watch every hit, run & out in a game (about 85 pitches) resulting in an action-packed 300k video stream of a complete ballgame that runs approximately 20 minutes. Condensed Games will be available to fans about 90 minutes after the completion of every game. MLB.com's multimedia content is played exclusively through RealNetworks RealOne player and will be demonstrated at a press conference hosted by Real Networks to introduce The Gold Release of RealOne in Los Angeles later today.

"We are very pleased to continue to break new ground in the development of exclusive audio and video services," said Bob Bowman, CEO of MLBAM. "While the best ways to watch a ballgame continue to be at the ballpark or on television, *MLB.com Condensed Games* offers geographically or time-displaced fans an alternate way to enjoy baseball."

Today's announcement represents the creation of another first-of-its-kind baseball subscription service from MLBAM. *Condensed Games* joins a number of returning starters to MLB.com's subscription service lineup. The official website of MLB now offers a number of exclusive audio and video services which made their debut last season, including *MLB.com Gameday Audio* – live & archived audio webcasts of all MLB games both home and away, and foreign language feeds when available; *MLB.com Custom Cuts* – a customizable, on-demand, video highlight service, enabling fans to create their own highlight reels of their favorite players; and *Baseball's Best*, a growing library of broadband video of the greatest games in baseball history soon to be expanded with original radio calls of classic games from the 1930's through the present.

The price of the new *Condensed Game* service will be announced shortly. A demo of the new service will be available on the MLB.com site following the conclusion of the Real Networks press conference in Los Angeles later today.

http://mlb.mlb.com/NASApp/mlb/mlb/homepage/mlb_homepage.jsp



TRI

THE OFFICIAL SITE OF MAJOR LEAGUE BASEBALL

Q & A with Royals owner David Glass
White Sox working to end baserunning blunders
Mets' Chen going the extra mile
Adrian Brown eager to take center stage
Lieberthal happy to be back in action
Saturday's Cactus League results
Saturday's Grapefruit League results
Four suspended, three fined from Angels, Padres
Pokey and Junior dissolve controversy
Henderson, El Duque have words

News / Feature Archive >>

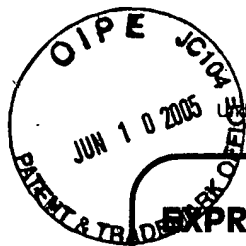
MLB Press Releases >>

MLB.com Press Releases >>

Kip Wells: Spring Training diary
Mark Redman: Spring Training diary
Schlegel: Nine more questions for spring
Carlos' Corner: It's good to clear your head
Molony: McClendon brings in The Cobra
Carlos' Corner: You have to have a short memory
In his own words: Jon Lieber
Reggie Sanders: This Giants team is awesome
Vina: Good to get back out there
Molony: Astros trying to solve 3B problem

Select a team

3/17/02

**EXPRESS ABANDONMENT UNDER 37
CFR 1.138**

Send Completed forms to:

Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/858,470
Filing Date	June 2, 2004
First Named Inventor	George Michael MOCKRY
Art Unit	3711
Examiner Name	M. Chambers
Attorney Docket Number	006385.00002

Please check only one of boxes 1 or 2 below:

(If no box is checked, this paper will be treated as a request for express abandonment as of the filing date of this paper.)

1. ☒ **Express Abandonment**

I request that the above-identified application be expressly abandoned as of the filing date of this paper.

2. ☐ **Express Abandonment in Favor of a Continuing Application**

I request that the above-identified application be expressly abandoned as of the filing date accorded the continuing application filed herewith.

NOTE: A paper requesting express abandonment of an application is not effective unless and until an appropriate USPTO official recognizes and acts on the paper. See the Manual of Patent Examining Procedure (MPEP), section 711.0

TO AVOID PUBLICATION, PLEASE USE FORM PTO/SB/24A INSTEAD OF THIS FORM.

I am the

☐ applicant.☐ assignee of record of the entire interest. See 37 CFR 3.71
Statement under 37 CFR 3.73(b) is enclosed.☒ attorney or agent of record.☐ attorney or agent acting under 37 CFR 1.34(a) (may act only if box 2 above,
stating that the application is expressly abandoned in favor of a continuing
application, is checked). Attorney or agent registration number if acting under
37 CFR 1.34(a).

(Attorney or agent registration number)

Signature

Joseph M. Skerpon

Typed or Printed Name

June 10, 2005

Date

202 824 3112

Telephone Number

COPY

Note: Signatures of all the inventors or assignees of record of the entire interest or their representatives(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.